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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1953

No. 228

**EMANUEL L. MAZER AND WILLIAM ENDICTER,
DOING BUSINESS AS JUNE LAMP MANUFACTUR-
ING COMPANY,**

Petitioners.

vs.

**BENJAMIN STEIN AND RENA STEIN, DOING BUSI-
NESS AS REGLOR OF CALIFORNIA**

Respondents.

**ON WRIT OF CERTIORARI TO THE UNITED STATES COURT
OF APPEALS FOR THE FOURTH CIRCUIT.**

Brief for the Petitioners

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Brief for the Petitioners

*To the Honorable the Chief Justice of the United States
and the Associate Justices of the Supreme Court of the
United States:*

OPINIONS BELOW.

The opinion of the trial court of the United States District Court in Baltimore, Maryland, appears in the record, pages 57-66. It is reported in 111 F. Supp. 359. The opinion of the Court of Appeals reversing the trial court appears in the record pages 70-84. It is reported in 204 F.S. (2) 472.

The prior opinion of the Court of Appeals of the Seventh Circuit with which the opinion of the Court of Appeals of the Fourth Circuit is in direct conflict is *Stein v. Expert*, reported in 188 F. (2) 611, (1951), *Certiorari* denied 342 U. S. 829. The opinion of the District Court in Chicago, Illinois, which was affirmed by the Court of

Appeals of the Seventh Circuit is reported in 96 Fed. Supp. 97.

The same issues were presented and decided in the District Court in Detroit, Michigan in the Sixth Circuit in *Stein v. Benaderet*, reported in 109 Fed. Supp. 364 (1952). An appeal to the Court of Appeals of the Sixth Circuit is presently pending.

The same issues were presented and decided by the District Court in Los Angeles, California in the Ninth Circuit in *Stein v. Rosenthal*, 103 F. S. 227 (1952). On appeal, the defendants admitted the validity of the copyrights involved and the remaining issues were recently affirmed, June 26, 1953. 205 F. (2) 633.

JURISDICTION.

Jurisdiction is based upon a direct conflict in the judgments of the Courts of Appeals of the Fourth Circuit and the Seventh Circuit.

Jurisdiction is also based upon the fact that in Circuits other than the Fourth and Seventh, and particularly in the Sixth and in the Ninth Circuit, there is litigation involving the same subject matter and the interpretation of the identical Federal Statutes. The District Court in the Sixth Circuit followed and adopted the decision of the Court of Appeals of the Seventh Circuit. The District Court and the Court of Appeals of the Ninth Circuit rejected it.

A petition for a writ of certiorari to the Court of Appeals for the Fourth Circuit was filed August 3, 1953 and was granted October 12, 1953. The order granting the writ invited the Solicitor General of the United States to file a brief "setting forth, along with other matters he deems pertinent, the views of the Copyright Office and a statement of its relevant practice." (R. 87).

QUESTION PRESENTED.

The actual question presented is—Can statuettes be protected in the United States by copyright when the copyright applicant intended primarily to use the statuettes in the form of lamp bases to be made and sold in quantity and carried the intentions into effect?

Stripped down to its essentials, the question presented is:

CAN A LAMP MANUFACTURER COPYRIGHT HIS LAMP BASES?

U. S. Statutes Involved.

Design Patent Statutes.

- 1842—5 Stat. 543, Sec. 3.
- 1870—16 Stat. 198, Sec. 71.
- 1902—32 Stat. 193.
- 1952—35 U.S.C. 171; 66 Stat. 792.

Copyright Statutes.

- 1790—Copyright Act of May, 1790.
- 1870—16 Stat. 198, 212, Sections 86, 100.
- 1874—Sec. 4952, Revised Statutes.
- 1909—35 Stat. 1076 Sections 5, 25b.
- 1947—17 U.S.C. Sections 1(a), 1(b), 5, 101(b)
(First)

Copyright Regulations.

- 1926 (re-enactment of 1909)
17 U.S.C.A. West-Bound vol. 1 page 182
- 1949 (also called 1950 and presently in force)
Title 17 U.S.C.A. 1 (1952) Sections 202.8
and 202.9 pp. 332-333.

STATEMENT OF FACTS.

The petitioners and respondents are the defendants and plaintiffs respectively in the trial court below. The suit was based on defendants' manufacture and sale of electric table lamps, no statues being involved. (R. 57)

The respondents herein as plaintiffs in 1950 filed a suit in the United States District Court in Chicago, alleging infringement of certain copyrights on statuettes. These statuettes were embodied by respondents as bases in electric table lamps, said lamps being manufactured and sold by respondents in quantity throughout the United States. The District Court in Chicago entered a judgment that the copyrights were invalid and that the subject matter of the copyrights should have been subjects for applications for design patents in the United States Patent Office. The opinion of the District Court was reported in 96 Fed. Supp. 97 (1951), *Stein v. Expert*.

Respondents appealed to the Court of Appeals for the Seventh Circuit and the judgment of the District Court was affirmed. The opinion is reported in 188 F. (2) 611 (1951). Respondents petitioned for a writ of certiorari, which was denied 342 U.S. 629, *Stein v. Expert*.

The respondents filed suit on the same copyrights or similar copyrights against other defendants in Los Angeles, Detroit and Baltimore. The identical issues were involved in each of these cases. The second case tried was in the United States District Court in Los Angeles, California. The District Court decided in favor of respondents holding the copyrights valid and infringed. *Stein v. Rosenthal*, 103 F.S. 227 (1952).

Respondent's third case was tried in the District Court in Detroit, Michigan. This involved the identical copyrights as in the California case and the charge of infringe-

ment was also predicated on electric table lamps manufactured by the defendant. The District Court in Detroit, after a consideration of the opinions of the District Courts in Chicago and Los Angeles, and the Court of Appeals of the Seventh Circuit, rendered its opinion and judgment and agreed with the opinion and judgment of the Court of Appeals of the Seventh Circuit in *Stein v. Expert, supra*, and specifically rejected the decision in the California case of *Stein v. Rosenthal, supra*. The complaint was dismissed. *Stein v. Benaderet*, 109 F.S. 364 (1952). This third case is now on appeal by Respondents.

Respondents fourth case was tried in the United States District Court in Baltimore, Maryland, which is the trial court in the case at bar. The suit was based upon similar copyrights, the alleged infringements also being electric table lamps. The trial court below (Judge Coleman), after considering the opinions and decisions of the Courts in the Seventh Circuit and of the District Court in Los Angeles, California, rendered its opinion and judgment in accordance with the opinion and judgment of the Court of Appeals of the Seventh Circuit and specifically rejected the reasoning and decision in the California case. The opinion of the Baltimore District Court, in favor of the Petitioner appears in the record pages 57-66 and is reported in 111 Fed. Supp. 359, *Stein v. Mazer*.

Respondents appealed to the Court of Appeals for the Fourth Circuit and a few days prior to the hearing by the Court of Appeals, The Attorney General of the United States, through the Solicitor for the Library of Congress, filed a brief as amicus curiae and supported the position of respondents. The Court of Appeals for the Fourth Circuit reversed the trial court below and held the copyrights valid and infringed. In its opinion, the Court of Appeals for the Fourth Circuit took direct issue with the

Court of Appeals for the Seventh Circuit. The opinion appears in the record pages 70-84 and is reported in 204 F. (2) 472.

Subsequent to the opinion in the Fourth Circuit, the Ninth Circuit Court of Appeals on June 26, 1953, affirmed the District Court in the Los Angeles case, 205 F. (2) 633.

The copyrights involved in the case at bar were first claimed by respondents in connection with sales of complete electric table lamps bearing alleged copyright notices. (R. 8-10—Interrogatories; R. 10-14—Answers; R. 15—Stipulation.) The claims to copyright were registered (R. 31-37) by respondents in the Copyright Office by filing applications accompanied by statuettes or copies of statuettes (R. 20-21), which statuettes were embodied as lamp bases in the table lamps as sold.

Complete table lamps whose bases were the statuettes as bases were made and sold in large numbers (R. 10-14) throughout the United States, such table lamps carrying copyright notices.

The statuettes were designed for use as bases in table lamps. Only ten statuettes alone were sold compared to 7,440 complete lamps. (Chart on page 35 of brief, based upon Record.)

ERRORS TO BE URGED.

1. In holding that a copyright on a statuette is valid even though the applicant for the copyright intended primarily to use the statuettes in the form of lamp bases and did so use them.

2. In failing to hold that a lamp base must be the subject of an application for a design patent rather than an application for copyright in case an applicant desires

to secure a Federal monopoly thereon under present statutes.

3. In holding that a lamp manufacturer may protect the design of an electric table lamp which he intends to and does produce in substantial quantities for sale and obtain a monopoly on the design of such a lamp base under the copyright laws rather than under the design patent laws.

4. In failing to hold that a lamp manufacturer who designed a lamp base intending it to be primarily sold as a lamp, and whose first sales were as lamps did not comply with the requirements of the copyright law by submitting a statuette as a work of art and relying on the date of sale of such a lamp as the publication date of the work of art.

5. In reversing the trial court in the *Baltimore* case and failing to follow the decision of the Court of Appeals in *Stein v. Expert*, 188 F. (2) 611; certiorari denied 342 U.S. 629.

SUMMARY OF ARGUMENT.

Fundamental considerations of law and economics require a critical examination of every monopoly purported to be created under the copyright or patent laws. A challenge to the legality of such a monopoly is a matter of right and should be encouraged to a reasonable degree.

Respondent manufacturers of electric table lamps had statues designed to be used as bases in a line of electric lamps manufactured and sold throughout the United States. The publication or sale of the items to be copyrighted as required by copyright law and regulations was accomplished here with complete electric lamps, while the

copyright registration for filing the copyright was accompanied with the statue in each instance. The respondents intended, as evidenced by their acts, to avoid the examination procedure in the Patent Office in connection with design patent applications and instead, took advantage of the copyright law to register a claim to copyright on an article of manufacture, which included as a part thereof an alleged work of art.

The Constitution is the source from which copyright and patent legislation stems. The copyright laws and patent laws enacted at various times in the history of the United States, derived from a common constitutional source, must be interpreted as complementary and not overlapping or conflicting. The very nature of government demands that laws administered by separate governmental bureaus be thus construed to prevent duplication of service rendered to the public and conflict between such separate government bureaus.

The copyright and patent grants constitute monopolies and represent the consideration or reward from the public to the creator or inventor, as the case may be. The primary consideration, however, is the disclosure by the creator or inventor to the public and because this is the primary consideration, it is incompatible with the public interest that a copyright claimant or applicant for patent be given the right to select either of these two monopolies at will. The copyright monopoly and patent monopoly in practice work out to similar ends and provide generally similar protection and the differences are due to the 28-year duration of the copyright monopoly, coupled with punitive damage provisions as distinguished from the maximum 14-year monopoly and reasonable damage provisions in the patent monopoly.

Fundamentally and historically, the Copyright Office is the repository of what each claimant considers to be a cultural treasure, whereas the Patent Office is the repository of what each applicant considers to be evidence of the advance in industrial and technological fields. In 1842, design patent protection was first made possible. Up to 1870, copyright protection which had been provided by previous enactments was confined solely to writings. In 1870, patent and copyright legislation were consolidated and for the first time, copyright protection was enlarged to include "works of fine art." Design patent protection had been and still continued to be directed toward the esthetic or artistic side of articles of manufacture.

A design patent is issued after a critical examination by the Patent Office to determine that the subject matter is both ornamental and original and has been invented by the applicant. The copyright monopoly is created by publication or sale (in those cases where the copyrighted work is to be published or sold) of the work with a copyright notice thereon and the copyright claim is registered in the Copyright Office of the Library of Congress by depositing a sample or best edition of the copyrighted work, together with a simple application and government fee.

In 1902 and 1909, the Design and Copyright Acts respectively were modernized and streamlined. Both of the acts, however, retained their previous coverage as regards "works of fine art" going to the Copyright Office and "works of art" constituting articles of manufacture going to the Patent Office. The 1909 Copyright Act omitted *fine* from "works of fine art", but the history of the legislation together with the interpretation by the Copyright Office from 1909 to 1949 indicates that the omission of *fine* was

for the purpose of eliminating a superfluous word rather than changing or broadening the meaning of "works of fine art".

The present design patent law is substantially the same as the 1902 design patent law and covers "a new and ornamental design for an article of manufacture." The Patent Office has issued patents under previous design acts from 1842 up to date on articles of manufacture having artistic merit.

The expression "works of fine art" as used in the original Copyright Act of 1870 and effectively repeated in 1909, and in the present enactment, confines the field of copyright protection only to works of fine art. This has been defined by this Court as painting, original statuary and sculpture, and the definition and understanding of "works of fine art" requires that the work have artistic value only and be free of any practical utility. The conception of original work of fine art also precludes the mechanical duplication of the original form of the work of fine art and is in harmony with the fundamental conception of artists that the creation is unique. A work of fine art as Cellini's saltcellar has only a theoretical utility.

A fundamental objective of art is to make a creation for reaching and affecting the intellect and emotion of a person to sway such person. An artist when creating what he considers to be a work of fine art, puts his creation into physical form with no consideration of duplication in quantity. In many instances, an original work of fine art cannot be duplicated by mechanical means.

By asserting a claim to statutory copyright, the creator of a work of art asserts to the world that his creation is a masterpiece and a work of fine art and is not to be

degraded by transforming the item to an article of manufacture.

The interpretation of the Copyright Office on "work of art" as used in the 1909 Act, carried forward in the 1947 Act, adhering to the traditional concept of the Copyright Office in registering claims for copyright of works of fine art only, is conclusive upon the respondents, upon the public generally, and upon the Copyright Office.

The attempt of the Copyright Office to enlarge its field of operations beyond works of fine art into the field of articles of manufacture, having some artistic appeal results in a clear encroachment upon the field of operation of the Patent Office and will result in undermining the operation of the Patent Office in administering design patent statutes.

The obvious advantages of copyright protection over design patent protection reflected in the certainty of creation of the copyright monopoly and the long duration, as well as the effective enforcement provisions incident to the copyright monopoly will result in a host of monopolies being created and will be conducive to a condition of utter chaos.

While the question of possible duplication or overlap of Copyright and Patent laws has been considered in a few isolated instances and by scholars such as Weil and De-Wolf, the policy and regulations of the Copyright Office in confining its operations to "works of fine art" generally rendered such questions and discussions moot. However, the change in policy of the Copyright Office, reflected in its new regulations adopted in 1949, in expanding copyright protection to industrial design has engendered substantial litigation and has made the question of overlap an active issue.

ARGUMENT.

Every Monopoly Should Be Critically Examined.

The position of the petitioners is based upon the most fundamental proposition in the field of legal economics—no monopoly restraining free competition should be tolerated except when clearly sanctioned by law. In the field of patents, both mechanical and design, a challenge to the legality of the alleged monopoly is regarded as a right, valuable in its tendency to protect the public interest, this in spite of the examination procedure in the United States Patent Office providing for protection of the public interest, however imperfect that may ultimately prove to be. In the field of copyrights, the registration procedure in the Copyright Office of the Library of Congress leaves the public interest completely unprotected. No examination is made by the Copyright Office. *Burrough-Giles Lithographic v. Sarony*, 111 U. S. 53; 59. The monopoly allegedly created under the copyright laws must therefore be examined with more than ordinary care.

The respondents are manufacturers of electric table lamps. A partner in the respondent firm designed a number of bases for their line of table lamps (R. 40B). These bases included statuettes. In order to obtain a monopoly on their lamp designs, the respondents took advantage of the copyright laws. Based upon the sale of a complete table lamp with notice of copyright thereon, respondents submitted with their copyright application a statuette alone and registered their self-created monopoly in the Copyright Office. For a \$4.00 fee, plus a simple form filled in in duplicate and the postage on the application form (the copyright samples or pictures as the case may be are carried free

(for 28 years plus a
possible 28 year renewal)

(postage) the respondents registered a monopoly on a statuette as a work of art while actually exercising the monopoly on a complete article of manufacture having actual utility. The record here shows sales by respondents of 7,440 electric table lamps and 10 statuettes. The statuette sales occurred long after the first sales of the lamps. (Chart on page 35 of this brief.)

In *Stein v. Benaderet*, 109 F.S. 364 E. D. Mich. S. D. 1952, involving the same issues including all copyright registrations involved here and including the respondents as plaintiffs (the defendants were different) the District Court found that respondents manufactured and sold almost 10,000 table lamps and only 5 statuettes as copyrighted were sold. At that these 5 were sold to one person after some adverse comment on this state of affairs had been made in a decision by still another Court in a still different litigation instituted by respondents.

The respondents have taken different positions in this entire series of litigations throughout the United States. First, they have asserted that Copyright and Design Patent laws overlap and that the creator of a work of art can select as his reward the monopoly under one or the other laws. Second, they assert that the Copyright laws contemplate not simply works of fine art but works of art generally. Third, they assert that the artist applicant, one of the partners in a lamp manufacturing business, deserves the protection of the Copyright laws in spite of

- (a) deliberately selecting copyright registration instead of submitting to examination in the Design Patent Division;
- (b) making an electric table lamp and selling it under claim of copyright while submitting only the statuette part to the Copyright Office as a work of art.

There is a fundamental reason why the copyright and design patent laws should be interpreted not to overlap.

The basis for and policy of the copyright and patent law is stated in Article I Section 8 of the Constitution.

“The Congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

To carry out this general policy, the Congress has created the United States Patent Office and the Copyright Office in the Library of Congress. Each of these two bureaus fulfills its own peculiar function and, for the most part, there is no dispute as to the fundamentally different natures of these functions.

There is a field, however, wherein the functions of the Copyright Office and Patent Office are contiguous as contended by us, and overlapping as contended by the respondents. From the very nature of Government, however, it is submitted that no overlapping fields of operation for two separate Government bureaus should be found unless the statutes defining the functions of these bureaus can only be reasonably interpreted in a manner to support overlapping.

The contiguous fields relate to “works of art, models or designs for works of art” and “reproductions of a work of art” in the Copyright Act and “a new, original and ornamental design for an article of manufacture” in the Design Patent Statutes.

The pertinent portions of the Copyright Act must be interpreted not only in its own environment in the Copyright Act but in relation to the Design Patent Statutes.

The effect of the decision of the Court of Appeals of the Fourth Circuit is to give the lamp manufacturer here

the privilege of selecting the Copyright or Design patent monopoly as a reward for disclosing to the Copyright Office a statuette as a work of art and disclosing and offering for sale to the public electric table lamps obviously having utility as well as ornamental value.

This makes a mockery of this Court's admonition in *United States v. Paramount Pictures, Inc.*, 334 U. S. 131.

"The copyright law, like the patent statutes, makes reward to the owner a secondary consideration."

The primary consideration of disclosure to the public in this instance assumes a dualism. To the Copyright Office the disclosure is a statuette as a work of art. To the public the disclosure is an article of manufacture in the form of an electric table lamp having utility and manufactured with impersonal, mechanical uniformity in numbers to satisfy public demand.

The Court of Appeals for the Seventh Circuit (*Stein v. Expert*, 188 F.(2) 611 - 1951) on the other hand denied the lamp manufacturer (respondents) this alternative privilege and held that the Design Patent statutes provided the proper basis for obtaining protection. This decision is in fundamental harmony with the reciprocal consideration basis for both patent and copyright laws as set forth in the Constitution.

The ease and certainty of the unilateral action, the longer term with automatic right of renewal, the nominal government fee, the more powerful rights created under copyright laws immediately raises the question why any one should choose the harder way under the Design Patent laws. Before alleging that monopoly rights may be created under one or other set of statutes, it is necessary to see if these statutes are not in fact mutually exclusive rather than overlapping.

The fundamental philosophies underlying the pertinent portions of the copyright laws and design patent laws.

Prior to the adoption of the United States Constitutional Provision, Article I, Section 8, dealing with copyrights and patents, twelve of the original thirteen States had copyright laws which protected copyrights only on books, pamphlets, maps and charts. Delaware had no copyright laws. (Library of Congress Bulletin No. 3, Copyright Enactments 1782-1900).

The rights under the various State Copyright Laws were transferred from the States to the Federal Government.

The first Federal Copyright Act of May, 1790 was entitled

“An Act for the encouragement of learning by securing the copies of maps, charts and books to the Authors, to Proprietors of such copies during the time therein mentioned.”

Fine art was not protected at all. The first Section of this Act dealt with authors and proprietors of books, and used the words “print”, “reprint”, “publish” or “vend”, in relation to books, maps and charts. Said words were used in the Copyright laws of the twelve States, and said words are likewise used in the present Copyright Act.

The Patent Act of 1790, 1 Statutes at Large, 109 entitled “An Act to promote the progress of useful Arts”, (Walker on Patents, Deller’s edition of 1937, vol. 1, page 514), contemplated only mechanical patents and did not provide for designs.

There was originally a wide gap between copyrights and patents. In 1842 the field of patent coverage was enlarged by legislation to provide design patent coverage to cater

to the esthetic needs of business. Such patent coverage has been and still is drawn to include *ornamental* designs for articles of manufacture. It has consistently been held that the utilitarian aspects of an item are not to be considered in a design patent and design patent coverage has always been based upon the beauty of the article to be manufactured.

The copyright laws were enlarged in 1870 so that "paintings, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts" were included.

A tabulation of the pertinent parts of the various Copyright and Design Patent laws from 1842 to date is opposite the concluding page 46 and may be unfolded for reference while reading this brief.

Practical monopolies under the copyright and design patent laws are the same except for longer duration of copyrights.

It has been contended, particularly on behalf of the Copyright Office, that the monopoly granted under the copyright laws is fundamentally different in nature from the monopoly granted under the design patent laws. The argument is that a design patent covers not only the actual design disclosed in the patent but also variations which are considered to be patentable equivalents. In the case of a copyright, the argument is that only the identical item under copyright is protected and any change negatives infringement. An additional argument is that a party who innocently recreates the copyrighted item is free of the copyright monopoly.

In the practical administration of the design patent and copyright laws, the courts have allowed the design pat-

entee or copyright owner substantial leeway in holding infringement of the respective monopolies. For copyrights, in the recent case of *Woolworth v. Contemporary Arts, Inc.*, 344 U. S. 228, involving the question of damages only in this Court, the District Court of Massachusetts in that case, *Contemporary Arts, Inc. v. Woolworth*, 99 F.S. 739, applied this rule, as stated in its opinion, page 743:

"There are some differences between the plaintiff's plaster model * * * and the Woolworth ceramic model * * * But, of course, it is not necessary that a copy be a 'Chinese copy' in order to find infringement." (citing cases).

The same leeway has been given to the design patentee. *Gorham v. White*, 81 U. S. 511.

Thus the actual monopolies enjoyed by the copyright owner and design patentee after creation of the monopoly work out in practice to be the same, except for the longer duration of copyright.

With regard to the second proposition that only the wilful or deliberate copier is guilty, the fact is that wilful infringement is presumed unless the defendant clearly proves to the contrary. A *prima facie* case of copyright infringement is the same as a *prima facie* case of design patent infringement.

In many instances it is a practical impossibility to prove that the alleged infringer exercised originality, and doubts on this score are resolved against him. It should be observed that the copyright owner's allegation of originality is only questioned in hazardous litigation and this constitutes a valuable and powerful advantage. If it is assumed that a copyrighted item becomes very popular, then innocent recreation to avoid infringement becomes impossible.

The more popular a copyrighted lamp base (as an example) becomes, the more nearly copyright protection approaches design patent protection as far as benefits are concerned.

With respect to the damage provisions, the Copyright Act is much more severe than the Design Patent Act. Because of the heavy penalties of the Copyright Act, judicial review of the various provisions of the new regulations becomes so hazardous as to render the same practically impossible.

The effect of the decision below and respondent's contention undermines entire design patent law administration.

If a manufacturer of an ornamental utilitarian item, as an electric table, can entrench himself against competition and create his individual monopoly, then the Design Patent Laws become a dead letter. Under the punitive recovery provisions of the Copyright Law and the fact that the copyright monopoly is created at the whim of the manufacturer, the public will always be on the defensive. Such a state of affairs makes the primary consideration in copyrights the monopoly to the manufacturer. Consideration or benefit to the public becomes a poor second.

The purported benefit to the public of a disclosure under the Copyright Law of an alleged work of art becomes the shackle to restrain competition.

Present copyright law pertinent to respondents' statues has not changed since 1870.

In 1870 the copyright and patent laws were consolidated in one act. The laws were administered by the Copyright Office of the Library of Congress and Patent Office respectively. The copyright portion of the 1870 Act spe-

cifically defined copyright coverage as being confined to works of *fine art* insofar as paintings, statues and sculpture were concerned. The same 1870 law referred to "original designs for a manufacture, bust, statue" as well as "articles of manufacture" as subject matter for design patents examined in the Patent Office. Works of fine art have always been restricted to *original* painting, statue and sculpture having no utility, created solely for the sake of art. This definition has been made by this Court in *U. S. v. Perry*, 146 U. S. 71. The implication is clear that the work of fine art must be the actual creation of an artist and not some article that has been manufactured, and certainly not a mass produced article.

It is thus clear that *original* statues not for manufacturing in quantity is work of fine art and the creative artist is encouraged to register his statue in the Copyright Office. The same act of 1870 directed an artist or any one who produced an original design for a bust or statue or an ornamental design for an article of manufacture to the Patent Office for design patent protection. The difference between the works of art handled by the Copyright and Patent Offices lay in the fact that the Copyright Office only handled fine art.

The government brief below and respondents' brief below practically concede that, for the issues here, the 1870 Copyright Act remained unchanged until 1909 and that between 1870 and 1909 the copyright registrations in issue would not have been legal.

Respondents allege that their rights to register for copyright a statue or lamp, either to be manufactured in quantity, originated in the 1909 Copyright law and continued without interruption to date.

We agree that the present 1947 copyright law, as regards the issues here, is the same as the 1909 Copyright law. The enactment of the 1909 Copyright law was prompted principally by new problems arising out of the development of the motion picture industry and mechanical reproduction of music. The Committee report on the bill enacting the 1909 Copyright law (this report is found in Howell's COPYRIGHT LAW 3rd edition 1952 pp. 253-277) amply supports this. The 1909 law streamlined the 1870 law with respect to works of fine arts comprising paintings, statue and sculpture. The 1909 law in no way enlarged the coverage of the 1870 law with respect to paintings, statue and sculpture, as we will show by the interpretation of the Copyright Office.

The 1909 law omitted "fine" from "works of art" as superfluous. The regulations of the Copyright Office from 1909 to 1949, over a third of a century, interpreted "work of art" as work of *fine* art and generally administered the law in that regard. The Copyright Office referred work of art other than fine art to the Patent Office for design patent protection. For convenience the pertinent copyright regulation is herewith given.

Regulation (1909—1926 reenacted—1949) (17 U.S. C.A. West Bound Vol. p. 182)

"12(g) Works of art and models or designs for works of art.—This term includes all works belonging fairly to the so-called *fine* arts (paintings, drawings and sculpture.)

The protection of *productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented depends upon action under the patent law*; but registration in the Copyright Office has been made to protect artistic drawings notwithstanding they may afterwards be utilized for articles of manufacture.

Toys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics, or similar articles are examples. The exclusive right to make and sell such articles, should not be sought by copyright registration." (Emphasis supplied)

The above regulation was not changed in the 1926 revision of the copyright regulations.

The 40 year construction placed upon the copyright law by the Copyright Office in its own regulation governing the practice is "in the highest degree persuasive, if not absolutely controlling in its effect." as said by this Court in *United States v. Graham*, 110 U. S. page 221.

The regulation quoted above, first promulgated in 1909, spelled out the traditional role of the Copyright Office as the repository for works of *fine* art, not as a receiving station for articles of manufacture having both ornamental and utilitarian values. Patent protection was specifically mentioned for the latter by the regulation.

The construction of the Copyright law given in the regulation quoted has a solid basis in the law. The 1909 law uses "work of art" without specifically defining this expression. Reference to section 86 of the 1870 act shows that specific items of "painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts" were added for the first time to the field of copyright protection. The 1909 act integrates these items in "works of art; models or designs for works of art" in what has been and is now section 5 of the 1909 and present 1947 copyright acts.

The expression "reproductions of a work of art" in (h) of section 5 has always been defined by the regulations as "reproductions—as contain in themselves an artistic ele-

ment distinct from that of the original work of art which has been reproduced" and thus contemplates additional or supplementary artistry as distinct from the original artistry.

To show that the 1909 act, insofar as painting, statue and sculpture is concerned, carried forward the provisions of the 1870 act, we may consider the provisions dealing with infringement liabilities. Section 101 part (b) of the 1947 Copyright Act which repeats section 25(b) of the 1909 act provides

"First. In the case of a painting, statue, or sculpture, ten dollars for every infringing copy made or sold by or found in the possession of the infringer or his agents or employees;"

The act of 1870, which is conceded by respondents to be limited to fine arts, provided as follows:

Section 100 (1870 Act.)

"and in case of a painting, statue or statuary, he shall forfeit ten dollars for every copy of same in his possession, or which have by him been sold or exposed for sale."

The Committee report (Howell's The Copyright Law, 3rd ed. pp. 253-277) preliminary to the enactment of the 1909 act, made no specific comment on the elimination of "fine" from works of art and the general streamlining of the language embracing pertinent copyrightable subject matter. This indicates that the new legislation to be enacted in 1909 was not radically different insofar as works of art are concerned.

The contention of respondents that the 1909 act worked a fundamental change in the law with respect to works of art is not borne out. If any change in the relationship between design patent and copyright fields had been con-

templated, the 1909 Committee report would most certainly have indicated. This Committee also handled patent legislation.

In the Committee hearings prior to the 1909 act, the Librarian of Congress testified

" . . . the term 'work of art' is deliberately intended as a broader specification than 'works of the fine arts' in the present statute with the idea that there is subject matter (for instance, *of applied design, not yet within the province of design patents*), which may properly be entitled to protection under the copyright law." (Emphasis supplied.)

(Testimony of Mr. Herbert Putnam, Librarian of Congress, before the Committee of Patents of the House of Representatives on June 6, 1906, p. 11.)

The above clearly indicates an intention on the part of the sponsors of legislation not to overlap the activities of the Patent Office. The established practice of the Patent Office since 1840 to date has included designs with classical form and figure as applied to articles of manufacture. The book of exhibits filed herewith is a small but representative collection of early design patents showing this. Current design patents are illustrated in the Record, pp. 43-56.

The interpretation by the Copyright Office of the 1909 law as exemplified in the copyright regulations from 1909 to 1949 is fully justified.

1902 Design Patent Act had no effect on copyright field.

The beginning of the forty-year period during which the Copyright Office interpreted "works of art" as works of fine art began in 1909, seven years after the passage of the 1902 Design Patent Act. This 1902 Act streamlined the language of the earlier Act of 1870 (the Copyright and

Design Patent Acts were consolidated) and amendments in much the same manner that the 1909 Copyright Act streamlined the language of the 1870 Copyright Act.

The Design Patent Act of 1902 changed the 1870 language

“new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, * * * may, * * * obtain a patent therefor”

in the 1870 Act, to the 1902 language

“Any person who has invented any new, original, and ornamental design for an article of manufacture, * * * may, * * * obtain a patent therefor.”

in the 1902 act, which language has been retained to the present day.

The respondents and Court of Appeals below interpreted the streamlining of the 1902 Design Patent Act as narrowing the scope of design patents. This view of statutory interpretation is diametrically opposite to the view by respondents of the same streamlining in the 1909 Copyright Act. It is clear that both the 1902 design patent law and 1909 copyright law had similar effects in their streamlining of the earlier cumbersome language of 1870 without broadening the subject matter in either act.

This view in regard to the 1902 Design Patent Act is supported by the letter from the Commissioner of Patents, Mr. Allen, in 1902 to the Senate Committee on Patents.

Commissioner Allen in sponsoring the 1902 Design Patent Act stated:

"Sec. 4929, as it stands at the present time, contains the specific statement of a number of different subjects to which designs may be applied. The proposed statute removes all this specific statement, for the reason that as the statute stands it does not include all the subjects which ought to be included and from the inclusion of a portion it suggests the non-inclusion of those not mentioned. It is to be noticed however, that in spite of this enumeration of subjects of designs, the Act of February 4, 1887, which furnishes a remedy for infringement of design patents, gives this remedy against those who, without the consent of the owner, apply the design secured to 'any article of manufacture', or to those who sell or expose for sale 'any article of manufacture to which such design' shall be applied. Therefore, if the remedy is in terms applicable to any article of manufacture, the enabling act means nothing more by the enumeration of a lot of different subjects, and they have been on this account removed from the proposed statute." (Emphasis supplied.)

(Senate Report No. 1139, 57th Congress, accompanying Bill S. 4647, dated April 18, 1902)

The Present Design Patent Laws.

The statutes governing the issue of design patents are found in Title 35 of the United States Code. Section 171 provides that "whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefore, subject to the conditions and requirements of this title."

The term of a design patent may be $3\frac{1}{2}$, 7 or 14 years at the election of the applicant and requires government fees of \$10.00, \$15.00 and \$30.00 respectively. The design application is subject to examination and the statute re-

quires that the new and ornamental design must be patentable over prior known designs. The statutes relating to infringement provide for injunction and a minimum award of \$250 which may be increased to cover the excess of such profit made by the infringer over and above \$250.

Design patents cover only esthetic part of an article of manufacture.

It has long been well accepted law that a patent for a design relates only to the ornamental or esthetic aspect of an article of manufacture and has no relation whatsoever to the utility thereof. In fact, design applications have been rejected and patents invalidated if the design is dictated by mechanical or utilitarian considerations. The statute authorizing the issue of design patents has from the very beginning required that the design be new, original and ornamental.

This Court in the case of *Gorham v. White*, 81 U.S. 511, 525, defined the essential characteristic of a design patent. This case has never been altered or overruled by this Court and is applied by all lower courts in construing the objectives of the design patent statutes. On page 525 in the above decision this Court stated:

“It is a new and original design for a manufacture, whether of metal or other material, a new and original design for a bust, statue, bas relief, or composition in alto or basso relieva; a new or original impression or ornament to be placed on any article of manufacture * * * or a new or original shape or configuration of any article of manufacture—it is one or all of these that the law has in view. *And the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form.*” (Emphasis supplied.)

Perverved issue as presented by respondents in the court below.

In respondents' brief page 5 before the Court of Appeals in the Fourth Circuit—and the opinion of the Court of Appeals reflects this—the respondents stated that the real question presented is:

“Where an artist — using traditional sculpturing techniques — creates and copyrights a statue with the intent of fulfilling the public demand both for the statue, per se, and for lamps embodying the statue, is the copyright infringed by one who copies the statue in a lamp?”

The question as presented to the Court of Appeals by respondents begs the very issue presented, namely, is the copyright valid? An invalid copyright obviously cannot be infringed. The question also assumes compliance with the terms of the Copyright Act by the copyright applicant. This is questioned in the opinion by the United States District Court in the case of *Stein v. Benaderet*, 109 F.S. 364—1952 previously referred to on page 13 here. This is the case where the Court found that the copyright applicant intended the statue as a base for a lamp, manufactured almost 20,000 of these lamps and sold only 5 statues to one person and made this sale following a legal decision in which another court referred to the fact that plaintiffs (respondents here) had sold none of their copyrighted product as statuettes.

It is clear, therefore, that the issue as defined by respondents in the court below and upon which the Court of Appeals based its decision, does not accurately reflect the facts here and is quite different from the question presented for decision here—Can a lamp manufacturer copyright his lamp bases?

In this connection, it is pertinent to observe that the litigation instituted by respondents in the Ninth Circuit resulted in a decision by the Court of Appeals which was based upon the admission by the defendants in that litigation to the effect that the copyright was valid. Thus, the Court of Appeals in the Ninth Circuit had no occasion to consider the validity of the copyrights and simply concerned itself with infringement.

The question presented for consideration to this Court is based not upon the activities of petitioner but upon what the respondents have done. In other words, this entire issue questions the validity of the copyright based upon the actions of the respondents. Certainly no unauthorized acts of the petitioners could impair the validity of the respondents' copyright if the respondents themselves were free of fault. This important issue was completely lost sight of in the Court of Appeals for the Fourth Circuit. Instead—and it is apparent from the opinion of the Court of Appeals—the court focused its attention upon what the petitioners had done and assumed that the respondents pursued a proper course and had valid copyrights.

Distinguished authors have considered issues here and their conclusions favor petitioners' interpretation of copyright law.

In the work "American Copyright Law" by Arthur W. Weil, 1917 edition, page 84, the following quotation appears. This work is concerned with the 1909 Copyright law.

"It should be noted that the only rights given the owners of copyright in completed works of art, in Section 1, are those given by sub-division (a). In view of the existence of the statutes covering design patents, it is probable that under the copyright law, copyrightable designs or models are limited to those

for works falling within the fine arts, although cases can be readily conceived where the work might be one of fine art, because of its form and execution, and a work of useful art because of its intended use. In such an event, both a copyright and a patent should be procured for perfect protection." (Emphasis supplied.)

Section 1 (a) gives the right "To print, reprint, publish, copy and vend the copyrighted work;" Section 1 (b) gives the right"; to complete, execute, and finish it if it be a model or design for a work of art;"

In DEWOLFES—An Outline of Copyright Law (1925) p. 91, the author defines "works of art" and "reproductions of works of art."

"(g) Works of art; models or designs for works of art. Herein are included works of *fine arts*, such as paintings, sculpture and drawings, but not works of the useful arts, which are within the sphere of patent protection. *It would be desirable that the copyright law should contain special provisions for works of art applied to industry, and such legislation has been recommended, but so far not adopted.* The design patent act, however, provides protection for "new, original and ornamental designs for articles of manufacture". (U.S. Revised Statutes, sec. 4929).

(h) Reproductions of works of art. This class was intended to cover such works as engravings, lithographs, etchings, and other reproductions in which the reproducer has embodied an element of original artistic labor, upon which the copyright in each separate reproduction is based. Such reproduction, in order to secure copyright, must be made with the consent of the copyright proprietor of the work reproduced, unless such work is in the public domain." (Emphasis supplied.)

These scholars indicate that the design patent laws are the sole and exclusive means for protecting table lamps and other articles of manufacture.

**Fine arts defined by this court in the case of
United States v. Perry.**

The above case reported in 146 U.S. 71 was decided in 1892. This case concerns itself with the determination of whether stained glass windows were in the category of works of fine art or a work of industrial design. The case was brought under the provisions of a tariff act in existence at that time. This Court pointed out that the fundamental objective of a tariff act is to protect United States industry and United States labor from foreign competition. Such a consideration would apply to articles of manufacture contemplated by Design Patents as against works of fine art for copyright. The decision turned upon whether the item in question was such a work of art as to be subject to the duty imposed.

This Court on page 74 and 75 considered the subject of works of art broadly and divided works of art into four classes, as follows:

“For most practical purposes works of art may be divided into four classes: 1. The fine arts properly so called, intended solely for ornamental purposes, and including paintings in oil and water, upon canvas, plaster, or other material, and original statuary of marble, stone, or bronze. These are subject to a duty of 15 per cent.

2. Minor objects of art, intended also for ornamental purposes, such as statuettes, vases, plaques, drawings, etchings, and the thousand and one articles which pass under the general name of bric-a-brac, and are susceptible of an indefinite reproduction from the original.

3. Objects of art, which serve primarily an ornamental and incidentally a useful purpose, such as painted or stained glass windows, tapestry, paper hangings, etc.

4. Objects primarily designed for a useful purpose, but made ornamental to please the eye and gratify the taste, such as ornamented clocks, the higher grade of carpets, curtains, gas-fixtures, and household and table furniture."

The object of art in a larger sense transcends ornamentation and partakes of a psychic quality in its desire to influence the intellect and evoke an emotional response. In distinction to this, the utilitarian quality in anything is directed to the physical sense and needs.

This Court in its definition of fine art undoubtedly had the larger objective of art in mind, and like the Court, we will use "ornamental purpose" in the sense as described here. It is, of course, well known that many works of fine art are hardly ornamental in the sense that they evoke pleasure or would be desirable to live with.

Only the first class was defined as fine art and included paintings, *original* statuary of marble, stone or bronze.

The second class defining minor objects of art is also intended for ornamental purposes but this Court pointed out that such minor objects of art are susceptible of an indefinite reproduction from the original. In other words, they can be manufactured in quantity. It is clear that fine art is not commercially reproducible in quantity.

The third and fourth classes are defined as having some useful purpose and it should be noted that Class 4 includes gas fixtures. With the substitution of electricity for gas in illumination, it is obvious that electric fixtures as lamps would now be put into this classification.

This Court pointed out that despite the evident artistry of a high order of stained glass windows that they were

still products of industrial design. An electric table lamp would certainly fall in this same category and fall within design patent protection.

Example of copyrighted items.

In 1949, the Copyright Office adopted new regulations which perverted the Copyright law to justify registering such random items as follows:

From catalog of copyright entries. Vol. 1, parts 7-11 A, No. 2 (July-Dec., 1947) "Works of Art".

- Design for button—GU 6636 (p. 89)
- Pin up pig bank—GP 6079 (p. 90)
- Design for glove bag—GP 6348 (p. 90)
- Leather Tooling Design—GP 6742 (p. 91)
- Design for bed spread—GP 6155 (p. 91)
- Design for puppet stage and packing box combined—GU 7061 (p. 91)
- Design for sewing selector—GU 6182 (p. 91)
- Design for collapsible lamp shade—GU 5903 (p. 93)
- Design for cemetery monument—GP 6831 (p. 96)
- Doll design—GU 6819 (p. 96)
- Bottle opener (metal figurine)—GP 5990 (p. 97)
- Models for ash tray—GU 5945 (p. 97)
- Designs for lamps—GU 6563 (p. 98)
- Design for costume jewelry—GU 7148 (p. 98)
- Design for hat and for container—GU 6834 (p. 98)
- Design for game board—GP 6418 (p. 99)
- Design for metal compact—GU 6709 (p. 100)
- Model for child's purse—GU 5981 (p. 102)
- Design for a belt buckle—GP 5923 (p. 105)
- Ladies purse, billfolds design—GU 6164 (p. 105)

The above designs are for articles of manufacture having utility and are fundamentally similar to respondents' designs.

Statue and lamp containing statue as base are distinct items having no relation to each other.

In accordance with the requirements of the Copyright law and regulations it is necessary for a person desiring copyright to publish the work with copyright notice thereon and register the copyright by depositing in the Copyright Office best editions of the work containing the notice of copyright together with an application (a simple form to be filled in) and fee of \$4.00. (Sections 10—et seq. of Copyright Regulations)

As given on the reverse of the copyright application form (Record 32) "The 'date of publication' in the case of a work of which copies are reproduced for sale or public distribution is defined in the Copyright Act as 'the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority'."

Respondents here "published" electric table lamps allegedly carrying the copyright notice by selling the same. Thereafter respondents purported to comply with the copyright filing requirements by sending to the Copyright Office white plaster statuettes as the alleged best edition. In the copyright applications, the dates of first publication of the alleged copyrighted item in each such application was the date of sale of the complete lamp. As the attached chart on page 35 shows, the respondents made no sales of the statuettes corresponding to the copies filed for registration until long after the date of publication alleged in the application.

**PLAINTIFFS' PUBLICATION DATES AND SALE OF
ELECTRIC TABLE LAMPS AND STATUETTES**

(1)	(2)	(3)	(4)	(5)	(6)
Copyright Certificate Number	Publication Date Alleged in Copyright i.e. date of first sale.	Date First Lamp Sold	Date First Statuette Sold	Lamps Sold of Each	Statuettes Sold of Each
E-1721	July 15, 1949	July 15, 1949	Aug. 10, 1950	958	2
E-1723	July 15, 1949	July 15, 1949	Aug. 10, 1950	1098	2
E-1717	July 10, 1950	July 10, 1950	Nov. 22, 1950	2046	4
E-1724	July 10, 1950	July 10, 1950	Nov. 22, 1950	1829	1
CIH-1738	Jan. 25, 1950	Jan. 25, 1950	Nov. 24, 1950	759	1
CIH-1737	Jan. 25, 1950	Jan. 25, 1950	(none)	750	(none)
				<hr/> 7440	<hr/> 10
				Total Lamps Sold	Total Statuettes Sold

Compiled from Defendants' Interrogatories (R. 8-10);
Plaintiffs' Answer to Interrogatories (R. 10-14); Stipula-
tion, R. 15; and Copyright Certificates (R. 31-37).

A table lamp which includes a statue as its base is not a "reproduction of a work of art" within the meaning of this phrase. The statue itself is still the same statue whether it is in the lamp base or outside of the base. But a lamp containing a statue is a different article than a statue alone. The copyright law, creating a long monopoly with minimal requirements from a registrant, has always been strictly construed. The law requires that the item submitted for copyright registration conform with the work of art published or sold. For three dimensional works of art, as statue or sculpture or for paintings, the law and regulations permit photographs to be filed in the Copyright Office in place of the original work of art or in place of exact copies thereof.

In the present case, the registrant did not comply with the requirement of the law and the copyright is therefore invalid.

The zeal of the Copyright Office to expand its field of operations is responsible for new policy not justified by law.

The 1949 regulations illustrate a tendency on the part of the Copyright Office to extend its field of operations unless curbed. That the Copyright Office had its eye on business rather than on the law when adopting the 1949 regulations is evidenced in an article entitled "Copyrighting Jewelry" by Sam B. Warner, Register of Copyrights, Library of Congress, published in the September, 1948 issue of Jewelers' Circular—Keystone—reproduced in the appendix. The article discusses the shortcomings of design patent procedure and then under the heading of "work of art" the author indicates that he is not sure of his legal ground. First the author states that he may be wrong

in thinking that artistic jewelry is subject to copyright. Then he states (Appendix pp. C, D)

“Even if I am wrong in believing that artistic jewelry is copyrightable, jewelry manufacturers have little to lose by trying to copyright it. The fee for copyright registration is very low, only \$4.00, and ordinarily, it is not a complicated process. A competitor is likely to feel that it is better not to copy a piece of artistic jewelry that bears a copyright notice, than to take the risk of having to pay the heavy statutory damages which would be imposed if he were wrong.”

The conflicting opinions of the Courts of the 4th and 7th Circuits and other decisions.

The Court of Appeals for the 7th Circuit in *Stein v. Expert*, 188 F. (2) 611, 612 conflicting with the decision in the 4th Circuit of the case at bar and involving the same issues in its opinion stated:

“Congress has provided two separate and distinct classes or fields of protection, the Copyright and the Patent.”

The Court of Appeals explicitly considered design patents relative to copyrights. In an earlier decision in 1943, *Taylor Instrument Company v. Fawley-Brost Co.*, 139 F. (2) 98 the Court of Appeals for the 7th Circuit had held that there was no overlap between copyrights and patents.

The opinion in the case at bar of the Court of Appeals for the 4th Circuit expressly states that it does not pass upon the question of overlap of copyright and design patent fields. In the case of *De Jonge and Co. v. Breuker and Kessler Co.*, 235 U. S. 33 (1914), the question of possible overlap was *not* considered by the Supreme Court.

The Supreme Court of the United States noted in the case, (page 36)

"The Circuit Court of Appeals, reserving its opinion as to whether the sphere of copyright and patent for design overlapped, agreed with the Circuit Court that if this was a painting, every reproduction of it must bear the statutory notice (of copyright) and affirm the dismissal of the bill."

The Court of Appeals for the third Circuit in this *De Jonge* case had stated—*De Jonge v. Breuker*, 191 F. 35,

"In this case the Circuit Court (trial court) decided that a painting, if it possess artistic merit, be suitable, also, for use as a design, may at the owner's election, be protected either by copyright or by patent *on this broad question we express no opinion.*" (Emphasis supplied)

In the *De Jonge* case before the Supreme Court of the United States in the opinion, Justice Holmes remarked (page 37)

"The appellant is claiming the same rights as if his work were one of the masterpieces of the world, and he must take them with the same limitations that would apply to a portrait, a holy family, or a scene of war."

The above *De Jonge* case was brought under the provisions of the 1909 Copyright Act. It is apparent from the above quoted remark that a copyright applicant by the act of copyrighting asserts to the world that his painting is a work of fine art on par, in the opinion of the copyright applicant, with the masterpieces of the world. The statuette of respondents, under the above decision, is being placed on par by respondents with the masterpieces of the world and the claim to the copyright by respondents is accordingly limited as has been pointed out before.

In the recent case of *F. W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228, the sole question before this court was the measure of recovery, and particularly the "in lieu" provision in the copyright law. The subject matter of the copyright in this case was "Cocker Spaniel in Show Position." The Woolworth Company innocently had purchased the statuettes from a source that had copied the copyrighted dog statues. Even though the Woolworth Company purchased these dogs in good faith and thus were innocent infringers, nevertheless the punitive provisions present in the copyright law were applied. In this *Woolworth* case, the copyrighted item was purely ornamental, having no utility.

The Court of Appeals for the 4th Circuit in its opinion (R. 82) in the case at bar stated that *King Features Syndicate v. Fleisher*, 299 F. 533

"involved an issue somewhat similar to that of the instant case."

In the *King Feature* case, the plaintiff has created cartoon characters known as "Barney Google", and "Spark Plug" or "Sparky", a horse. The plaintiff had published his cartoons and had syndicated them to newspapers throughout the country with wide circulation, running into millions, where they appeared daily as comic strips. Defendants manufactured a toy horse which was copied after plaintiff's cartoon character, "Splug Plug" and, in addition, labeled it and sold it as "Spark Plug" and "Sparky". The Court held that this was an infringement of plaintiff's rights.

The Court of Appeals in its opinion of the case at bar also relied upon *Fleisher Studios v. Ralph H. Freundlich, Inc.*, 73 F. (2) 276.

In the *Fleischer* case the plaintiff had created a new cartoon character known as "Betty Boop". This character had been exhibited in motion picture cartoons and had become very popular and widely known. In addition, plaintiff's licensee had sold large quantities of "Betty Boop" dolls. The Court there said:

(p. 278)—"What the appellant constructed is recognizable by an ordinary observer as having been taken from the copyrighted source. Such is an infringement."

To the same effect is *Hill v. Whalen & Martell*, 220 F. 359 wherein it was held that a dramatic performance using actors dressed like "Mutt" and "Jeff" infringed the copyrighted "Mutt and Jeff" cartoons.

After considering the above decisions the opinion of the Court of Appeals in the case at bar continues (Record 83)

"These cases differed from the instant case in that there the copyrightee did not use the copyrighted material in a form different from a form under which the material was copyrighted. In our case the material was copyrighted as statuettes, but was afterwards embodied by the copyrightee in a lamp base. Nor did the plaintiffs here create any fictional characters and associate them by name, such as 'Barney Google' or 'Betty Boop', which became well known to the public."

The logic in the above quotation appears to be misdirected. The very differences pointed out between the case at bar and the prior cases destroy the pertinence of such prior cases to the instant issues.

In *Bleistein v. Donaldson Co.*, 188 U. S. 239, relied upon by the 4th Circuit Court of Appeals, the plaintiffs had copyrighted three chromolithographs or pictorial illustrations used in advertisements for a circus. The Supreme

Court then held that *circus advertisements* are within the protection of the Copyright Laws. Obviously this case supports petitioner's position. It is printed material in whatever form produced that is protected by copyrights, not articles of manufacture.

The utility for which a unique masterpiece may be designed is theoretical and the artistic execution of the masterpiece disregards practical considerations for mechanical duplication.

Respondents have referred to such outstanding art treasures as Cellini's salt cellar in reference to copyright as against design patent protection. The respondents allege that, under the theory that a salt cellar has utility, following the petitioner's reasoning no copyright protection would be possible. The respondents' argument as applied to this example illustrates a superficial application of petitioner's reasoning.

First of all, it should be observed that the creators of art masterpieces of the world and of lesser works of art made their creations without regard to possible mechanical duplication. Many three dimensional works of art are impossible to reproduce mechanically because of undercutting or intricacy of the design. They can not be enshrouded within a mold and thereafter removed from the mold without breaking either the art work or mold into parts. The real artist pleases and expresses only himself and in his supreme egotism wants to leave only one of a work to posterity rather than a brood of one work to a contemporary public.

By contrast, an industrial designer or designer of applied art has his eye partly on art and partly on the problems of manufacture and sale. The creation of such an artist or designer is for duplication and is intended first

to please the public, rather than the artist, and to endow the product with such artistic lines as to make it susceptible to manufacture to insure commercial success of the item.

The objective of an industrial designer may have as much cultural and social value in a large sense as the objective of an artist who wants to create a unique work. However, society through the medium of government and enactment of copyright and patent laws has prescribed separate rewards to be claimed by one who asserts himself to be a creator of fine art or by the other who asserts himself to be the creator of articles of manufacture, however artistic they may be.

The selection as to whether he is a fine artist or designer of applied art is made by the creator in the act of claiming copyright or applying for design patent protection.

Apart from the question of freedom of artistic design present in fine art and absent in industrial or applied art, the question of utility is also present. It is true that Cellini made his art treasure ostensibly for holding salt. In view of the rarity of the item, it is a fair inference that the salt cellar never actually fulfilled its function as a salt cellar to be used by the public. The possible ceremonial use of this salt cellar at some state banquet of a patron of Cellini would be no evidence of utility. Its status as a museum piece removes it from the category of a salt cellar to a work of fine art.

It is apparent, therefore, that the utility of Cellini's salt cellar is theoretical. There is no question but that this salt cellar would qualify for copyright registration. If, however, Cellini designed and manufactured this item in quantity so that the general public could have salt cellars,

then an entirely different conclusion would be reached. In such case, the salt cellar becomes an article of manufacture having utility in addition to its ornamental value and would therefore have to be protected by design patent.

As Justice Holmes remarked in the *De Jonge v. Breuker and Kessler* case, 235 U. S. 33, 37

"The appellant is claiming the same rights as if this work were one of the masterpieces of the world, and he must take them with the same limitations that would apply to a portrait, a holy family, or a scene of war."

It is submitted that the distinction drawn here is the only practical distinction between copyright and design patent protection. To permit statutory copyright on any three dimensional item having some artistic attributes and alleged by the copyright claimant as being original would result in the creation of such a vast number of monopolies (whose legality is hazardous to determine) as to not only undermine the entire concept of design patent protection, but would have a profoundly adverse effect upon business generally. The contentions of respondents tend to impart a new and radical interpretation to the copyright laws.

The case of *Baker v. Selden* (101 U.S. 99-1879) considered the relationship between copyright and mechanical patent protection and held the two fields utterly distinct.

On page 105, this Court stated:

"The object of the one is explanation; the object of the other is use: The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters patent."

A work of art in its original form represents the artist's explanation of the subject matter. The manufacture in quantity of alleged art—with or without utilitarian characteristics—represents use of an ornamental article of manufacture and limits the article to design patent protection.

Respondents are misusing copyrights.

In *Morton Salt Co. v. Suppiger Co.*, 314 U.S. 488 (1942), this Court stated, p. 492:

"It is a principle of general application that the courts, and especially courts of equity, may appropriately withhold their aid where the plaintiff is using the right asserted contrary to the public interest. (citing cases)"

In the above case, the misuse of mechanical patents was condemned.

Many decisions have condemned the misuse of trademark rights. In *Edward Thompson Company v. American Law Book Company*, 122 F. 922, 926, and *Stone and McCarrick v. Dugan Piano Co.*, 220 F. 837, the misuse of copyright was condemned.

It is submitted that the respondents are misusing their copyright registrations in claiming a monopoly on an article of manufacture having utility, a table lamp in this instance, when in fact the copyright purports to cover, according to the claim filed in the Copyright Office, a statuette as a work of art.

New copyright policy is a disturbing influence.

The fact that the question of overlap of copyright and design patent laws was never passed upon by this Court before, even though the question had been discussed by students of copyright law and lower courts years ago, is believed to be due to the policy of the Copyright Office up to 1949, as enunciated by its regulations in generally confining its field of activities to works of fine art. Since 1949, the change in policy of the Copyright Office has encouraged copyright registrations of articles outside the proper sphere of activity of the Copyright Office and has

engendered considerable litigation. It is thus noteworthy that within about four years of the change of policy of the Copyright Office on "works of art", the formerly moot question of overlap of copyright and design patent law has become a live issue, to the point where Courts of Appeal disagree and requires the resolution of such differences by this Court.

It would therefore appear that the change in policy on the part of the Copyright Office as declared by its new regulation has resulted in hurting the public rather than helping it.

CONCLUSION.

The general punitive nature of copyright laws is known to the public and copyright notices engender fear and command respect. The article by Mr. Warner, Register of Copyrights, in the September, 1948 issue of the Jewelers' Circular-Keystone (in Appendix page A-E) illustrates this.

"Even if I am wrong in believing that artistic jewelry is copyrightable, jewelry manufacturers have little to lose by trying to copyright it. The fee for copyright registration is very low, only \$4.00, and ordinarily, it is not a complicated process. A competitor is likely to feel that it is better not to copy a piece of artistic jewelry that bears a copyright notice, than to take the risk of having to pay the heavy statutory damages which would be imposed if he were wrong."

The respondents here used the copyright procedure as a stratagem, to avoid the design patent statutes and requirements and also took advantage of the superior psychological value of a copyright notice as compared to any possible design patent notice. In short, respondents

used copyright as a scare weapon to suppress competition. This is contrary to public interest.

The petitioners therefore respectfully pray that:

1. The judgment of the Court of Appeals of the 4th Circuit in the case at bar be reversed and that the judgment of the District Court be affirmed.

2. The copyrights in issue here be declared null and void.

3. A copyright on a statuette is not valid when the claim to copyright is based upon the sale of a lamp embodying the statuette.

4. A copyright on a statuette is destroyed by the manufacture and sale in quantity of electric table lamps embodying the statuette when such sales are made by or under the copyright owner.

5. An electric table lamp manufactured and sold in substantial quantity is an article of manufacture and as such is not within the purview of the Copyright Code but if patentable, must be protected under the provisions of the design patent statutes.

6. A manufacturer of electric table lamps who designed a statuette base for a lamp, who sold lamps embodying the base, did not comply with the requirements of the Copyright Code by submitting the statuette alone as a work of art to the Copyright Office and alleging the date of sale of such lamp as the publication date of the work of art.

Respectfully submitted,

MAX R. KRAUS,

ROBERT L. KAHN,

Counsel for Petitioners.

Date—November 6, 1953.

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Excerpt from THE JEWELERS' CIRCULAR-KEYSTONE (Sept. 1948)

COPYRIGHTING JEWELRY.

Protecting a jewelry design by copyright is a simple process compared to the long, involved patent. Here's how to do it.

by SAM B. WARNER
Register of Copyrights
Library of Congress

“Why should a manufacturer of jewelry want to copyright his products? Is he not much better off to patent them?” I have often been asked. Certainly, he is. Patent protection is much broader than copyright protection. If the design for a piece of jewelry is patented, nobody in the United States can make jewelry according to that design for the life of the patent, even if he also originates a similar design in entire ignorance of the patented design. On the other hand, copyright gives protection only against copying. Nevertheless, protection against copying may be of great value. If one manufacturer puts an original artistic piece of jewelry on the market and shortly afterwards his competitor comes out with a piece that is a duplicate of it, a court is not likely to believe that the competitor did not know of the original product and copied it.

Most Jewelry Not Patentable

Patent if you can, but as you all know, most jewelry cannot be patented. Its design may be original and new, but still it may not be patentable. Nothing can be patented

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which is not the product of invention and invention requires a manifestation of genius, that is, of something beyond the power of the ordinary craftsman with knowledge of the prior art. Courts can very seldom be persuaded that new designs for jewelry contain the manifestation of genius necessary for an invention. But I need not tell you manufacturers why very little of your jewelry is patentable. You all have attorneys and doubtless all have tried to patent some of your best designs.

For copyright, invention is not necessary. I can walk up to the favorite spot for photographing the Washington Monument and snap my Brownie camera. I am the author of the resulting photograph. It is my product and I can copyright it even though thousands of people before me have snapped their cameras from exactly the same spot. My copyright will doubtless be valueless, at least in the United States, because it will not prevent anybody else from also photographing the Washington Monument and from making a photograph of it as much like mine as two peas in a pod. Similarly, if a manufacturer designs a piece of artistic jewelry that is just like other jewelry available in the United States, it will do him no good to copyright it. His copyright will prevent a competitor from copying his jewelry, but it will not prevent the competitor from copying other pieces of jewelry just like the copyrighted piece. Therefore, never try to copyright a piece of jewelry that you do not believe to be original.

“If it is worthwhile to copyright artistic jewelry, why is it not the practice of the trade to copyright such jewelry just as motion picture companies copyright their products and as cartoonists copyright the ‘funnies’?” you are doubtless asking. There are two reasons. One reason is that ideas of what can be copyrighted and what con-

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stitutes a work of art have gradually widened with the years. The other is that previous Registers of Copyrights have not been willing to accept artistic jewelry for copyright registration and no manufacturer has thought copyright of sufficient value to make it worth his while to spend the thousands of dollars necessary to go to court and force the Register of Copyright to accept his product.

Work of Art?

It is, of course, entirely possible that I may be wrong in thinking that artistic jewelry is copyrightable. The Constitution of the United States authorizes Congress to grant copyright protection to writings of authors. The early copyright acts covered only books and things akin to books. The present statute, however, also covers motion pictures, music, photographs, prints and labels, and in Class G "Works of art; models or designs for works of art." Former registers always accepted paintings and statues as works of art regardless of how poor these works were. For the most part they also accepted book-ends and ashtrays that were more or less artistic. I cannot see why if a book-end or an ashtray can be a work of art, it is impossible for a piece of jewelry to be a work of art. In fact, I cannot see why a piece of jewelry may not be just as much a work of art as many of the paintings and statues that everybody will admit to be works of art. Certainly the fact that jewelry has utility, if it has, is not the deciding factor, because nobody from his day to this has doubted that Benevento Cellini's saltcellar was both a work of art and a dispenser of salt.

Even if I am wrong in believing that artistic jewelry is copyrightable, jewelry manufacturers have little to lose by trying to copyright it. The fee for copyright registra-

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tion is very low, only \$4.00, and ordinarily, it is not a complicated process. A competitor is likely to feel that it is better not to copy a piece of artistic jewelry that bears a copyright notice, than to take the risk of having to pay the heavy statutory damages which would be imposed if he were wrong.

Note that I have referred throughout to artistic jewelry. Since the Copyright Act does not refer to jewelry as copyrightable, but only to works of art, jewelry that does not constitute a work of art cannot be copyrighted. Congress has not given the Copyright Office any criteria for determining when a piece of jewelry constitutes a work of art and the Office has not been able to devise any. But since Congress has ordered the Copyright Office to give copyright registration to works of art, the Office will obey and do its best to determine whether any piece of jewelry that you send to it for copyright registration is in fact a work of art. If it turns you down, it will return to you the money you have paid and the jewelry or photograph of the jewelry you have sent it.

Note also that I have referred to the manufacturer of a piece of artistic jewelry as its author. The Copyright Act speaks only of authors; the author of a musical composition, the author of a photograph, the author of a statue, and so forth. By the author of a piece of artistic jewelry is meant of course the man who designed the jewelry or the person or corporation that employed him to design it.

Suppose now that we have decided that it is worthwhile to try to copyright a new piece of artistic jewelry, the next question is how to do it. As you are manufacturers and only interested in jewelry that is manufactured for sale, we need not consider how to copyright designs for jewelry. You first must place the copyright notice, that is the letter

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C in a circle followed by the name of the copyright owner, that is the originator of the piece or his assignee, on every piece of jewelry that is to be protected by copyright. This should not be difficult. Silver manufacturers customarily place the word "Sterling" on their products. A "C" in a circle followed by the name of the manufacturer takes only a little more space. Even the back of an earring should be large enough to hold such a notice.

The next thing to do is to publish the jewelry, that is to place it on sale, sell it or publicly distribute it. When this has been done, an application for copyright registration on Form GG, \$4.00 and whatever number of photographs are necessary to identify the jewelry must be sent to the Copyright Office. Form GG explains the advantages and disadvantages of sending also two pieces of the jewelry. The Copyright Office will record the receipt of your application and send you a certificate of copyright registration. If your piece of jewelry is really a work of art, this certificate will prove of great value to you should you ever have occasion to prove your copyright in a court. If your piece of jewelry turns out not to be a work of art, the fact that you registered it in the Copyright Office will at least furnish you a permanent record of what you manufactured and when.